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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/713,770	11/16/2000	Adam Coyle		3444
20350 7590 03/19/2009 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834				
EXAMINER CAMPEN, KELLY SCAGGS				
ART UNIT 3691		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/713,770

Applicant(s)

COYLE, ADAM

Examiner

KELLY CAMPEN

Art Unit

3691

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22, 24-31 and 33-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22, 24-31 and 33-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 November 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

The following is in response to the amendments and remarks filed 12/17/2008. Claims 22, 24-31, 33-38 are pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 22, 24-31, 33-38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, in claims 22 and 37 it appears new matter has been added to the claims by way of the limitation "not having a relationship with a banking institution" appears to limit that the account holder has no bank account whatsoever. The specification appears to be silent to this limitation even going so far as reference number 104 in the drawings is a "bank account". Without having an FDIC insured bank along the way, federal benefit checks and payroll checks may not be deposited.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 22, 24, 25, 30-31, 33-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gatto (US 6149055) in view of Marcous et al. (US 5650604).

Gatto discloses system (and method as per claim 37) for issuing prepaid negotiable instruments to an account holder, comprising: a database for storing, in relation to a prepaid account of the account holder, an account identifier and a balance associated with the prepaid account, (see col. 10, lines 60-65—travelers checks are the negotiable instrument issued--), wherein withdrawals against the prepaid account are made only by issuance of negotiable instruments, and wherein the prepaid account is maintained by a non-banking institution and the prepaid account is thus not an FDIC insured account (see col. 10, lines 60-65 and column 9, lines 35-40); a transaction terminal for issuing negotiable instruments, the terminal including a card reader for reading a card having data thereon representing the account identifier, an input device for entering the amount of the negotiable instrument, and a printer for printing the amount on the negotiable instrument (col. 6-8 and abstract, col. 2, lines 27-37); a server system in

communication with the database and the transaction terminal, the server system receiving the account identifier in response to the card being read at the transaction terminal, accessing the database to determine the balance within the prepaid account associated with the account identifier, authorizing a negotiable instrument to be issued at the terminal if there is a sufficient balance within the account to cover the amount of the instrument, and debiting the prepaid account by the amount of the issued negotiable instrument (see col. 11, lines 13-20—account identifier—and col. 13 lines 65 to column 14 line 2); and a communication link connecting the server system for receiving data from a banking institution, (see col. 8, lines 50-52—prompt user for other transaction parameter--see abstract, col. 6-8) and the system of electronic funds may be used to issue negotiable instruments (col. 5, lines 40-45, in addition see abstract, see col. 2-5, see figs. 1, 5-6) wherein the account holder is a cash-based consumer not having a relationship with a banking institution, wherein funds are deposited for the benefit of the account holder into the bank account, wherein those funds can then immediately be swept into the prepaid account, and wherein the funds are accessed by the account holder only through the issuance of prepared negotiable instruments but does not specifically disclose wherein the balance represents funds deposited to the prepaid account as advance payment for negotiable instruments, the data relating to a bank account maintained by the banking institution for receiving deposits for the account holder and crediting those deposits to the prepaid account, immediately crediting the account, per se nor does Gatto specifically disclose a non- FDIC insured institution, per se. Gatto teaches transfers between a bank and a non bank in col. 10, lines 60-65, col. 9 lines 35-40 and col. 7 lines 66-67 to col. 8 line 5 as the system may store information which determines the particulate account, account type or particular institution with which the account is related (i.e. casino

account to bank account). In addition, Gatto teaches where the prepaid account is credited as soon as a communication link connection g the server for receiving data. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a non FDIC insured account as a casino account as taught by Gatto.

Marcous et al. disclose the data relating to a bank account maintained by the banking institution for receiving deposits for the account holder and crediting those deposits to the prepaid account as advanced payment for the negotiable and the prepaid account is non banking instrument (see col 3, line 59 to col. 4, line 15) and the data relating to a bank account maintained by the banking institution for receiving deposits for the account holder and immediately crediting those deposits to the prepaid account (see col. 2 -col 3).

It would have been obvious to one of ordinary skill in the art to include in the financial system of Gatto the ability to credit deposits to the prepaid account as advanced payment, the prepaid account is a non banking institution, and the data relating to that bank account maintained by the banking institution for receiving deposits for the account holder and immediately crediting those deposits to the prepaid account as taught by Marcous et al. since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Specifically as to claim 24, wherein the deposits received at the bank account are direct deposits through an automated clearinghouse (ACH) system (see col. 12 lines 45-47 and col. 16 lines 10-20).

Specifically as to claim 25, wherein a personal identification number (PIN) is associated with the card, wherein the card is presented by the account holder at the transaction terminal, and the PIN is entered at the input device of the terminal in order for the account holder to request issuance of a negotiable instrument (see col. 12 , lines 1-10).

Specifically as to claim 30, wherein the transaction terminal is an automated teller machine (ATM) (see col. 4 lines 8-10).

Specifically as to claim 31, wherein the transaction terminal is a point of sale (POS) terminal (see col. 10 lines 60-66).

Specifically as to claim 33, wherein the non-banking institution is a Licensed Money Transmitter (LMT), wherein the LMT requires a transaction fee for issuing the negotiable instrument, and wherein the transaction fee is deducted from the account when the negotiable instrument is issued (see col. 10 lines 60-66).

Specifically as to 34, wherein the server system authorizes a negotiable instrument to be issued at the terminal if there is a sufficient balance within the account to cover the amount of the transaction fee in addition to the amount of the negotiable instrument (see col. 10 lines 60-66 and col. 9 lines 30-50).

Specifically as to claim 35, wherein the printer prints the name of the account holder on the negotiable instrument so that the negotiable instrument is payable to the account holder (col. 10 lines 60-66).

Specifically as to claim 36, wherein the balance associated with the account and stored in the database is limited to a predetermined maximum value (see col. 10, lines 60-66).

Specifically as to claim 38, further comprising printing the name of the account holder on the negotiable instrument as the payee and printing a restrictive legend requiring identification in order to cash the negotiable instrument (see col. 10, lines 60-66).

Claims 26 -29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gatto in view of Marcous et al. as applied to claims 22, 24-25 above, and further in view of Henn (US 5770844).

Specifically as to claim 26, Gatto and Marcous et al. disclose as claimed above in claim 25 but do not specifically disclose, wherein the account is an anonymous prepaid account, wherein the database stores no identifying personal information concerning the account holder, and wherein the server system authorizes issuance of a negotiable instrument without requiring identifying information concerning the account holder other than the account identifier and the PIN.

Henn discloses wherein the account is an anonymous prepaid account, wherein the database stores no identifying personal information concerning the account holder, and wherein the server system authorizes issuance of a negotiable instrument without requiring identifying information concerning the account holder other than the account identifier and the PIN (see col 1, lines 53-65).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include in the financial systems of Gatto and Marcous et al. the ability to transact anonymously as taught by Henn since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function

as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Specifically as to claim 27, wherein the account is an anonymous prepaid account, wherein the database stores no identifying personal information concerning the account holder other than the account holder name to appear as payee on the negotiable instrument, and wherein the server system authorizes issuance of a negotiable instrument without requiring identifying information concerning the account holder other than the account identifier and the PIN (see col 1, lines 53-65).

Specifically as to claim 28, wherein the negotiable instrument is issued in the name of the account holder, and wherein the negotiable instrument is preprinted with a restrictive legend requiring identification for cashing the negotiable instrument (see col. 10, lines 60-65).

Specifically as to claim 29, wherein the negotiable instrument is further preprinted with a restrictive legend setting an upper limit for its face value (see col. 10 lines 60-65).

Examiner's Note

Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Response to Arguments

Applicant's arguments filed 12/17/2008 have been fully considered but they are not persuasive.

With regards to applicant's argument/statement on page 8, lines 12-14, that the Examiner suggested the features which were added by amendment were not in the claims but in the Specification are incorrect. Examiner stated that the features of which applicant relied upon were not in the claims, and while the claims are interpreted in light of the Specification, the features need to be in the claims. Examiner did not recite such features were in the Specification, merely that the features were in the arguments.

With regards to applicant's arguments of the newly added limitation at the end of claim 22, specifically the wherein clause, no weight has been given to this feature as it does not add to the system being recited as it is directed to functional descriptive matter. An apparatus/system is defined by what a device is, not what it does. The claim must distinguish in terms of structure not function. Recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus if the prior art apparatus teaches all the structural limitations of the claim.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that "funds are deposited for the benefit of the account holder into the bank account, wherein those funds can then immediately be swept into

the prepaid account, and wherein the funds are accessed by the account holder only through the issuance of prepared negotiable instruments” a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KELLY CAMPEN whose telephone number is (571)272-6740. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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